

REMARKS

Claims 1-20 are pending in this application. By this Amendment, claims 1-9 are amended, and claims 11-20 are added.

In particular, claims 1-9 are amended for better clarity, and not for any substantial reason related to patentability. New claims 11-20 are added to recite additional subject matter disclosed in the specification. (See the specification at, for example, page 10, lines 2-15).

Reconsideration of the application is respectfully requested.

The Office Action objects to claims 2, 3, 5 and 6. Claims 2 and 3 are amended to obviate this rejection. Accordingly, withdrawal of the objection of claims 2, 3, 5 and 6 is respectfully requested.

The Office Action rejects claims 1-3 and 7-9 under 35 U.S.C. §102(e) over U.S. Patent No. 6,567,367 to Ohno et al. This rejection is respectfully traversed.

As a preliminary matter, Applicant respectfully submits that the rejection of claims 1-3 and 7-9 is improper. The Office Action does not lay out the grounds for the rejection. The Office Action merely "supports" the position taken by the European Patent Office, referring to a European search report Applicant submitted with an Information Disclosure Statement. Furthermore, there is no evidence that the Examiner has reviewed the European application to determine whether its claims are the same as the claims of the U.S. application.

Applicant respectfully submits that the European search report merely indicates the relevance of the cited references as perceived by the European Patent Office with respect to the European claims, but does not lay out an element-to-element analysis for a rejection under 35 U.S.C. §102. Thus, the Office Action does not establish a *prima facie* case of anticipation. The Examiner is required to identify specifically where each claimed feature is found in reference to establish a *prima facie* case of anticipation, so that Applicant can recognize and seek to counter the grounds for a rejection. See Chester v. Miller, 15 USPQ2d 1333, 1337 (Fed. Cir. 1990).

In any event, Applicant respectfully submits that Ohno does not disclose or suggest the combination of features recited in the independent claims. For example, Ohno does not disclose or suggest a reference power which is preset so that an optical reflectance of the virtual recording cell is reduced more than 50% with respect to an initial reflectance, as recited in claim 1 and similarly recited in claim 7.

Ohno discloses a recording method using a phase change of the recording medium. See Fig. 1 and col. 9, lines 4-22. Ohno discloses forming amorphous marks during a solidifying process based on a balance between the crystalline growth speed and the cooling speed of the melted region. See col. 9, lines 23-27. Ohno discloses detecting reflected light based on the area ratio between the crystalline region within the focused light beam spot and the amorphous region in the spot. See col. 10, lines 55-61. Ohno does not disclose or suggest a percentage of reduction of optical reflectance with respect to an initial reflectance. Therefore, Ohno does not disclose or suggest a reference power which is preset so that an optical reflectance of the virtual recording cell is reduced more than 50% with respect to an initial reflectance, as recited in claim 1 and similarly recited in claim 7.

Furthermore, Applicant respectfully submits that Ohno does not disclose or suggest a recording layer being continuously formed in a relative moving direction to a laser beam with plural virtual recording cells, as recited in claim 1, and similarly recited in claim 7.

As discussed above, Ohno discloses a recording method using a phase change of the recording medium. See Fig. 1 and col. 9, lines 4-22. Ohno discloses the sizes of recrystallized regions and amorphous marks. See Fig. 1 and col. 9, lines 23-27. The sizes of the recrystallized regions and the amorphous marks are determined by the balance between the crystalline growth speed and the cooling speed of melted regions. See Fig. 1 and col. 9, lines 23-27.

Ohno discloses that the recrystallized regions are separate from, and with gaps between, each other in the beam scanning direction. See Fig. 1. Thus, Ohno's recrystallized

regions (apparently believed by the Examiner to correspond to the virtual recording cells recited in the claims) are not continuously formed in the beam scanning direction.

For at least the above reasons, Ohno does not disclose or suggest a recording layer being continuously formed in a relative moving direction to the laser beam with plural virtual recording cells, as recited in claim 1, and similarly recited in claim 7.

In view of the above, Ohno does not disclose each and every element recited in claims 1-3 and 7-9. Accordingly, withdrawal of the rejection of claims 1-3 and 7-9 under 35 U.S.C. §102(e) is respectfully requested.

The Office Action rejects claims 4 and 10 under 35 U.S.C. §103(a) over Ohno in view of JP 02-278535. This rejection is respectfully traversed.

JP 02-278535 discloses plural values of reflectance corresponding to the coloration of dye contained in the recording layer. See Abstract. JP 02-278535 does not disclose or suggest a recording layer being continuously formed in a relative moving direction to a laser beam with plural virtual recording cells, each of which has an arbitrary unit length and a unit width perpendicular to the unit length in the relative moving direction; or a reference power which is preset so that an optical reflectance of the virtual recording cell is reduced more than 50% with respect to an initial reflectance, as recited in claim 1 and similarly recited in claim 7. Thus, JP 02-278535 does not supply the subject matter lacking in Ohno.

Accordingly, Ohno and JP 02-278535, either individually or in combination, do not disclose or suggest the subject matter recited in claims 1 and 7, and claims 4 and 10 depending therefrom. Withdrawal of the rejection of claims 4 and 10 under 35 U.S.C. §103(a) is respectfully requested.

The Office Action rejects claims 1, 4, 7 and 10 under the judicially created doctrine of obviousness-type double patenting over a list of claims of U.S. Patent No. 6,611,484 and U.S. Patent No. 6,699,557. A Terminal Disclaimer is filed concurrently with this Amendment to overcome this rejection. Accordingly, withdrawal of the rejection of claims 1, 4, 7 and 10

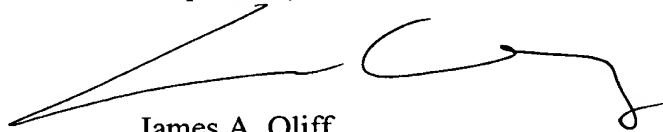
under the judicially created doctrine of obviousness-type double patenting is respectfully requested.

New claims 11-20 are believed to be patentable. For example, Ohno and JP 02-278535, either individually or in combination, do not disclose or suggest a reference power that enables a laser beam to reduce the reflectance of a recording medium more than 50%, as discussed above. Therefore, Ohno and JP 02-278535 do not disclose or suggest the subject matter recited in claim 11. In addition, Ohno and JP 02-278535, either individually or in combination, do not disclose or suggest reducing the reflectance of the recording medium to five different levels in a fraction of a time period during which a cell may be irradiated, as recited in claim 12.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-20 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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JAO:GXL/sqb
Attachment: Terminal Disclaimer
Date: June 17, 2004

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